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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,236	03/02/2004	Katsuyuki Masuda	Q79897	9838
23373	7590	09/19/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
			EXAMINER ADDY, THJUAN KNOWLIN	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 09/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/790,236

Applicant(s)

MASUDA, KATSUYUKI

Examiner

Thjuan K. Addy

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/02/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

2. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR  
DEVELOPMENT.

(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A  
COMPACT DISC.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37  
CFR 1.97 and 1.98.

- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A

“Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

3. The disclosure is objected to because of the following informalities: The specification of the utility application does not include the above sections in order. The lettered items, above, do not appear in upper case, without underlining or bold type, as a section heading. Appropriate correction is required.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakano (US 6,836,668).

6. In regards to claim 1, Nakano discloses a mobile phone system (See Fig. 1 – Fig. 2) which performs communication between a mobile phone terminal (See Fig. 1 and portable telephone terminal) and an opposite party terminal (e.g., receiving/opposite party) via a network, wherein the mobile phone terminal comprises means for transmitting a connection request of a packet switching line to the side of the network in addition to a calling connection request of a circuit switching line to the opposite party terminal or a calling connection response of a circuit switching line to the opposite party terminal in response to key operation of a user (for example, the key operation is performed by the user via keypad 10, See col. 4-5 lines 66-4), and means (See Fig. 2 and voice-to-character data converter 62) for transmitting data (e.g., character) corresponding to a desired voice message via a packet switching line connected with the network on the basis of the connection request (See col. 5 lines 37-53 and col. 6 lines 32-50), the network comprises data/voice message converting means (See Fig. 2

and character-to-voice data converter 63) for converting data transmitted from the mobile phone terminal via the packet switching line to corresponding voice message, and means for merging the converted voice message to the circuit switching line to transmit the same to the opposite party terminal (See col. 5-6 lines 54-5 and col. 6 lines 16-31), and a voice from the opposite party terminal is transmitted to the mobile phone terminal via the circuit switching line, while data from the mobile phone terminal is converted to a voice message by the data/voice message converting means to be transmitted to the opposite party terminal via the circuit switching line (See col. 1-2 lines 55-8 and col. 5-6 lines 37-5).

7. In regards to claim 2, Nakano discloses a mobile phone system, wherein the mobile phone terminal further comprises means for prohibiting transmission of the voice from the mobile phone terminal to the side of the network via the circuit switching line when the means for transmitting a connection request of a packet switching line to the side of the network is actuated (See col. 1 lines 55-64, col. 5 lines 37-53, and col. 6 lines 32-50).

8. In regards to claim 3, Nakano discloses a mobile phone system, wherein the network further comprises notification means, and when the means for transmitting a connection request of a packet switching line to the side of the network is actuated, the notification means notifies that the user of the mobile phone terminal has set a mode (e.g., first/voice-character communication mode or second/character-voice communication mode) (for example, the mode is set via key operation which is performed by the user via keypad 10, See col. 4-5 lines 66-4) where data is converted

to a voice message to be transmitted without transmitting a voice of the user via the circuit switching line to the opposite party terminal as a voice message (See col. 1 lines 55-64, col. 5-6 lines 54-5, and col. 6 lines 16-31).

9. In regards to claim 4, Nakano discloses a mobile phone system, wherein the means for transmitting data corresponding to a desired voice message, with which the mobile phone terminal is provided, transmits data corresponding to the desired voice message in response to key inputting of the user (for example, the key inputting of the user is performed via keypad 10, See col. 4-5 lines 66-4) (See col. 5 lines 37-53 and col. 6 lines 32-50).

### ***Conclusion***

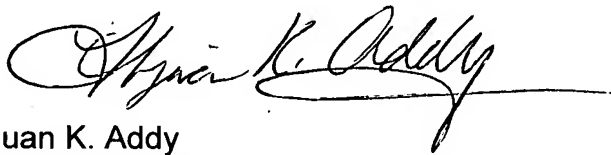
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wrede et al (US 5,937,040) teach a method and apparatus for using a D-channel for displaying user data. Deng (US 6,600,733) teach a system for interconnecting packet-switched and circuit-switched voice communications.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan K. Addy whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Thjuan K. Addy", with a long horizontal flourish extending to the right.

Thjuan K. Addy  
Patent Examiner  
AU 2614